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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/663,291	SAREEN ET AL.
	Examiner	Art Unit	
	Andrea N. Long	2175	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>27 January 2009</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,3,5-7,9,10,12,14,15,18-25 and 30-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,3,5 -7,9,10,12,14,15,18-25 and 30-32</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Response

In Applicant's Response dated 01/27/2009, Applicant amended claims 1, 3, 5-7, 9, 10,

12, 14, 15, 18-25, 30, and 32, and argued against all objections and rejections previously set forth

in the Office Action dated 10/27/2008.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
requirements of this title.

Claims 18-25, 30, and 31 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter.

Claims 18-25, 30, and 31 are considered software per se. Computer programs may be

explicitly claimed as, for example, a series of code or instructions for performing functions or

may be implicitly claimed as, for example, a user interface, a system, a module or an apparatus.

Where there is no evidence in the specification that a means which may be interpreted as

software, hardware or combinations thereof necessarily includes hardware, it will be interpreted

in its broadest reasonable sense as a software means, which is the case here.

While Applicant has attempted to overcome this rejection by amending the preamble of

the claim, it is the claim limitations that should explicitly recite hardware to perform the

functions of the user interface to overcome this rejection.

Thus a claim to functional descriptive material, including computer programs, per se, is

not patent eligible subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

Claims 1, 3, 5-7, 9-10, 12, 14-15, 18-25 and 30-32 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Tom Syroid et al. (Outlook 2000 In a Nutshell: A Power User's

Quick Reference, published May 2000, pages 15 and 244-252) hereinafter "Syroid" in view

of Diane Poremsky (Sams Teach Yourself Microsoft Office Outlook 2003 in 24 Hours,

2003), hereinafter Poremsky in further view of Microsoft Outlook (2000), hereinafter

"Outlook" in further view of Fortenberry et al (US Patent 6101485), hereinafter

"Fortenberry".

As to independent claim 1, Syroid discloses the *method for providing a user*

interface for defining an electronic message handling rule (p. 245 [003], p. 246 Fig 6-14 →

Syroid discloses rules for automated message handling in an email system), *the method*

comprising, receiving a request to create an electronic message handling rule, wherein receiving

the request to create the electronic message handling rule comprises receiving the request to create the electronic handling rule from a user interface button (p. 246 [004] [006] → Syroid discloses by selecting the Tools option to execute the Rules Wizard to create, modify or delete a rule). Syroid additionally teaches *upon selection of a user interface button for creating the electronic message handling rule, providing a user interface dialog box comprising a first portion for identifying conditions for the electronic mail handling rule* (page 251 Figure 6-17) *and a second portion for identifying action associated with the conditions* (page 249 Figure 6-15) (p. 244 [002], p. 247 [007] → Syroid discloses that the message handling system uses conditions and actions to create a rule).

Syroid does not explicitly teach *in response to the request, identifying a context in which the request to create the electronic message handling rule was received; wherein the identified context comprises receiving a subscription alert; providing a user interface for defining the electronic message handling rule, wherein a contents of the user interface is customized based on the identified context associated with an operation on the electronic mail message; wherein the identified context comprises a context comprising reading an electronic mail message* and *wherein the user interface button is displayed within an electronic message reading pane, drop down menus adjacent to at least one condition and action.*

Poremsky teaches *in response to the request, identifying a context in which the request to create the electronic message handling rule was received* (page 1, Figure 14.3) *wherein the identified context comprises receiving a subscription alert* (page 4), *wherein receiving the subscription alert comprises:*

receiving an electronic mail message (page 4 – alerts are sent by email),

   parsing the electronic message to determine whether the electronic mail message was generated by the subscription alert (page 4 – alerts are sent my email and you can use the create rule dialog to create a rule to handle the alert messages, these rules area added to the E-mail Rules list and are identified as alerts),

   in response to determining that the electronic mail message was generated by the subscription alert, providing a user interface button for creating the electronic message handling rule (page 4 advanced button in the rules wizard to the select conditions dialog, with the Which is an Alert E-mail condition preselected), *and*

   providing a user interface for defining the electronic message handling rule, wherein a contents of the user interface is customized based on the identified context associated with reading the electronic mail message (page 1, Figure 14.3);

   wherein the user interface for defining the electronic message handling rule comprises a first user interface object for defining at least one condition for the electronic message handling rule, wherein a drop down menu is adjacent to the at least one condition, wherein, in response to selecting the drop down menu, a list of entries displays customized conditions for the electronic message handling rule based on the identified context (page 1 Figure 14.3 – check box located beside sent to with the drop down for user selection of a sent to);

   at second user interface object for defining at least one action to be performed when the at least one condition is satisfied, wherein the at least one action to be performed comprises at least one of the following: displaying a new item alert window, selecting a sound, playing the selected sound, previewing the selected sound, moving the electronic mail message to a selected

folder, speaking selected text, and previewing the selected text, (page 1 Figure 14.3 – check box
beside play a selected sound) *and*

   *a third user interface object for defining the electronic message handling rule that
contains all of the possible actions and all possible conditions* (pages 1-3 Figures 14.3, 14.6, and
14.7 – the advanced options button opens the Rules Wizard at the Select conditions dialog).
While the action of speaking and previewing selected text is not explicitly taught by Poremsky,
one of skilled artisan is well aware of the method of text to speech, which can be used in e-mail
applications for converting text into sound for impaired users of a system.

   Both Syroid and Poremsky are in the same field of endeavor which is message handling
and it would have therefore been obvious to one skilled in the art at the time the invention was
made to have included the subscription alerts, user interface objects and advanced user interface
object of Poremsky with the system of Syroid to provided an efficient and easily operated user
interface for creating message handling rules.

   Outlook teaches a user selecting an electronic mail message (Figure 1 and 2) and while
viewing the message (Figure 2 and 3) having the option of selecting an action to create a rule
(Figure 3). When the action to create a rule is selected, the context of the message is populated
to create a condition based on the context of the message (Figure 4). Outlook additionally
teaches where a user interface button can be located at various regions of the Application, such
as in the Actions menu (Figure 3), in the applications menu bar and opened electronic email
message menu bar (Figure 5). It is reasonable to one skilled in the art at the time the invention
was made (e.g., a computer programmer who writes code for GUIs within an email application)
that the position of the button can be located in a wide variety of locations within the application

and electronic message at a user's preference for quick and convenient access. While Outlook

does not explicitly teach the button being located in the reading pane, it is reasonable for a button

to be present in the reading pane to perform a function similar to that of Fortenberry (Fig. 1,

column 2 lines 21-55, column 4 lines 38-41), which provides user selectable buttons within an

electronic message reading pane.

It would have been obvious to one skilled in the art at the time the invention was made to

have incorporated the additional options for accessing the messaging handling system as that of

Outlook and Fortenberry with Syroid in view of Poremsky to provide the user with quick access

to a user interface for creating a message handling rule.

As to dependent claim 3, Syroid in view of Poremsky teaches wherein the first *user*

interface object for defining the at least one condition for the electronic message handling rule

are a subset of all of the possible conditions for the electronic message handling rule (Fig 6-17

→ Syroid discloses in his figure that the conditions are grouped under a larger group of

conditions).

As to dependent claim 5, Syroid in view of Poremsky teaches *wherein the first user*

interface object for defining the at least one condition for the electronic message handling rule

comprises a fourth user interface object for setting a condition for the electronic message

handling rule based on an identity of a sender of the received electronic mail message (p. 250

[013], p. 252 [018] → Syroid discloses that one of the conditions of setting a flag can be applied

to a message sent from a specified individual).

As to dependent claim 6, Syroid in view of Poremsky teaches *wherein the first user interface object for defining the at least one condition for the electronic message handling rule comprises a user fourth interface object for setting a condition for the electronic message handling rule based on a subject of the received electronic mail message* (p. 250 [014], p. 252 [020] [022] → Syroid discloses that a condition could be based on content of a received message).

As to dependent claim 7, Syroid in view of Poremsky teaches wherein the first *user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on an identity of at least one intended recipient of the electronic mail message* (p. 250 [015], p.252 [019] → Syroid discloses that conditions could be set for messages that are sent to specified individuals).

As to dependent claim 9, Syroid in view of Poremsky teaches the first *user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on an identity of the intended recipient of the created electronic mail message* (p. 250 [015] → Syroid discloses that conditions could be set for messages that are sent to specified individuals).

As to dependent claim 10, Syroid in view of Poremsky teaches the *first user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on a subject of the created electronic mail message* (p. 252 [020] → Syroid discloses that messages sent which are created may set conditions based on specified words in the subject of a message).

As to dependent claim 12, Syroid in view of Poremsky teaches wherein *the at least one condition for the electronic message handling rule comprises receiving an alert electronic mail message generated as a result of the subscription alert* (p. 249 [011] → Syroid discloses that a user-specified notification message is displayed in reference to an important message alert. Page 4 - Poremsky teaches receiving a subscription alert via email).

As to dependent claim 14, Syroid in view of Poremsky teaches wherein *the first user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on the selected name* (p. 250 [013] [015] → Syroid discloses that conditions could be set for messages that are sent to specified individuals).

As to dependent claim 15, Syroid in view of Poremsky teaches wherein *the first user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the rule based on a subject of*

the received electronic mail message when the context comprises selecting a name (p. 252 [020]

→ Syroid discloses that a condition could be based on content of a received message).

As to independent claim 18, claim 18 recites substantially similar subject matter as that

of claim 1 and is rejected under the same rationale.

As dependent to claim 19, Syroid in view of Poremsky teaches *wherein the first user*

interface object for defining the at least one condition for the electronic message handling rule

comprises a fourth user interface object for setting a condition for the electronic message

handling rule based on the identity of a sender of the electronic mail message when the context

comprises reading the electronic mail message (p. 246 [005], p. 249 [010] [012] → Syroid

discloses that conditions and actions can be set for incoming messages to read based on content

of the message and the identity of the sender).

As to dependent claim 20, Syroid in view of Poremsky teaches *the first user interface*

object for defining the at least one condition for the electronic message handling rule comprises

a fourth user interface object for setting a condition for the electronic message handling rule

based on a subject of the electronic mail message when the context comprises reading the

electronic mail message (p. 250 [014], p. 252 [020] → Syroid discloses that conditions and

actions can be set for incoming messages to read based on content of the message).

As to dependent claim 21, Syroid in view of Poremsky teaches *the first interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the rule based on the identity of the at least one intended recipient of the electronic mail message when the context comprises reading the electronic mail message* (p. 252 [019] → Syroid discloses that conditions and actions can be set for outgoing messages based on the intended receiver).

As to dependent claim 22, Syroid in view of Poremsky teaches *the first user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on the identity of the intended recipient of the electronic mail message when the context comprises creating the electronic mail message* (p. 252 [019] → Syroid discloses that conditions can be set for messages created and being sent to an individual).

As to dependent claim 23, Syroid in view of Poremsky teaches *the first user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on a subject of the electronic mail message when the context comprises creating the electronic mail message* (p. 249 [009], p. 252 [020] → Syroid discloses the conditions could be set for messages that he user creates based on the content of the message).

As to dependent claim 24, Syroid in view of Poremsky teaches *the first user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on the selected name when the context comprises selecting a name* (p. 248 [008], p. 250 [013] → Syroid discloses that names can be selected from a database, with the selected names conditions can be set for that individual person or persons).

As to dependent claim 25, Syroid in view of Poremsky teaches *the first user interface object for defining the at least one condition for the electronic message handling rule comprises a fourth user interface object for setting a condition for the electronic message handling rule based on a subject of a received electronic mail message when the context comprises selecting a name* (p. 248 [008], p. 249 [010], p.252 [020] → Syroid discloses conditions can be based on incoming messages with specified content and from a specified person).

As to dependent claim 30 and 31, Syroid in view of Poremsky teaches a user interface for creating message handling rules and having multiple buttons for performing functions within the user interface.

Syroid does not explicitly teach *a simplified user interface containing a subset of all actions for defining the at least one condition and the at least one action for handling the electronic message.*

Outlook teaches an organize pane which gives a simplified version of rules that can be implemented on messages (Figure 7). Further Outlook displays a second interface button "Rules

Wizard", that when selected will provide additional more advanced features for creating rules to apply to messages (Figures 7-9). This feature provided by Outlook is a well-known method to one skilled in the art to allow novice users to interact with essential and common functions within the user interface and provide expert users with advanced options to further customize rules, more commonly seen in a dialog box with an "Advanced" button.

It would have been obvious to one skilled in the art at the time the invention was made to have combined the message handling rule interface of Syroid and Poremsky with the interface of Outlook to allow novice users to interact with essential and common functions within the user interface and provide expert users with advanced options to further customize rules.

As to independent claim 32, claim 32 recites substantially similar subject matter as that of claim 1, except that it is a system that implements the method of claim 1 with implicit devices as memory storage and a processing unit, and is rejected under the same rationale.

Response to Arguments

Applicant's arguments with respect to claims 1, 18, and 32 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that a new section (page 4) has been added to the prior art reference "Poremsky", which will be cited on PTO form 892 along with an updated copy for the Applicant. Poremsky is a book from which the Examiner has provided relevant portions of as they relate to the current claimed subject matter. Newly added page 4 has been added to teach the amendments associated with the subscription alert to which the Applicant's arguments are directed to.

On Page 16 of the Applicant Response, the Applicant asserts "In contrast, and as stated

by the Examiner, Syroid and Poremsky at least fail to disclose creating a message handling rule.

(See Office Action page 6, lines 18-21.) Consequently, because Syroid and Poremsky do not

disclose creating a message handling rule, Syroid and Poremsky cannot disclose providing a user

interface dialog box for creating a message handling rule upon detecting a subscription alert.

Accordingly, Syroid and Poremsky fail to disclose providing a user interface button and a dialog

box for creating a message handling rule".

Upon further review of the Office Action dated 10/27/2008, particularly to page 6, line

18-21, there is no mention of the Examiner making such statements as described by the

Applicant. In fact, page 6 of the Office Actions is used to teach the placement of the interface

button in the message and pages 4-5 forcefully recites and teaches Syroid and Poremsky creating

a message handling rule. Therefore the Applicants assertion has not been supported and is moot.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea N. Long whose telephone number is 571-270-1055. The examiner can normally be reached on Mon - Thurs 6:00 am to 3:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrea N Long/
Examiner, Art Unit 2175

                                                    /WILLIAM L. BASHORE/
                                                    Supervisory Patent Examiner, Art Unit 2175